

REMARKS

Applicants have carefully reviewed the Office Action dated June 3, 2005, and respectfully request reconsideration in view of the following remarks. Claims 23-52 are currently pending in this application.

Objections to the Specification

The Office Action notes that the specification contains trademarks and requests that the term be capitalized wherever it appears. The specification has been amended herein to clarify these proprietary marks.

Double Patenting

Claim 23 stands rejected under the judicially created doctrine of obviousness-type double patenting over claim 15 of U.S. Patent No. 6,093,407. A terminal disclaimer in compliance with 37 CFR 1.321(c) is filed herewith to obviate this rejection.

Claim 23 also stands rejected under the judicially created doctrine of obviousness-type double patenting over claim 16 of U.S. Patent No. 6,432,416. A terminal disclaimer in compliance with 37 CFR 1.321(c) is filed herewith to obviate this rejection.

Claims 23-30 were also provisionally rejected under the judicially created doctrine of obviousness-type double patenting over claims 2-22 and 53 of copending Application No. 10/185,545. This rejection is respectfully traversed, since the instant application is a divisional application filed as a result of a restriction requirement issued on July 28, 2002 in the above copending Application No. 10/185,545. This provisional rejection is therefore not permitted and should be withdrawn. (See MPEP 804.01)

Claims 31-43 also stand rejected under the judicially created doctrine of obviousness-type double patenting over claim 1 of U.S. Patent No. 6,093,407. A terminal disclaimer in compliance with 37 CFR 1.321(c) is filed herewith to obviate this rejection.

Withdrawal of the above provisional double patenting rejections is therefore respectfully requested.

Claim Rejections - 35 U.S.C. § 112

Claims 23-52 stand rejected under 35 U.S.C. § 112, first paragraph as the specification is allegedly not enabled. The rejection is respectfully traversed.

The present invention relates to an anti-microbial powder coating composition comprising one or more solid anti-microbial agents that are homogeneously dispersed within the powder or impact fused or both, and methods for preparing the same.

With regard to the §112, first paragraph rejection, the examiner considers the disclosure only partially enabling for the above claims. Specifically, according to the Office Action, the specification is "enabling for solid antimicrobial agents, FUNGITROL 11, PROPYL PARABENS, AMERSTAT 300, NUOCIDE 960, NUOSEPT S, TROYSAN 174P, CANGUARD 409, IRGASAN DP 400 AND AMICAL WP; and antimicrobial metal or metal ion" but "does not reasonably provide enablement for other antimicrobial agents." Applicants respectfully traverse this rejection.

While the Office Action refers to the *Wands* factors for assessing "undue experimentation," consideration of those factors is not necessary until the Examiner has made a *prime facie* showing of non-enablement and that has not occurred here.

It is well established that:

“... a specification disclosure which contains a teaching of the manner and process of making and using the invention in terms which correspond in scope to those used in describing and defining the subject matter sought to be patented *must* be taken as in compliance with the enabling requirement of the first paragraph of § 112 *unless* there is reason to doubt the objective truth of the statements contained therein which must be relied on for enabling support” *Fiers v. Revel*, 25 USPQ2d 1601, 1607 (Fed. Cir. 1993)(emphasis in original).

The instant specification “contains a teaching of the manner and process of making and using the invention in terms which correspond in scope to those used in describing and defining the subject matter sought to be patented.”

According to the Office Action, “[t]he present invention in unpredictable unless experimentation is shown for the other antimicrobial agents or other antimicrobial metal or metal ions such as gold or zinc.” Office Action at 8. However, the Office Action does not provide any evidence that the large number of anti-microbial agents, metals, and metal ions identified in the specification are “unpredictable” in the claimed invention.

The specification provides examples of anti-microbial agents, metals, and metal ions that can be used in accordance with the claimed invention. Specification at page 3, line 16 to page 4, line 24. For example, the specification recites that the anti-microbial agents can include, but are not limited to, phthalimides, acetamides, phthalonitriles, hydroxy benzoates, isothiazolinones, nitropropane diols, carbamates, methyl ureas, benzimidazoles, salicylanilides, mercury acetates, organozinc compounds, metals such as silver, copper and zinc, and ions of such metals. Id. Moreover, the specification gives the person having ordinary skill in the art examples of suitable commercially available examples of the different solid anti-microbial agents.

The Office Action does not provide or suggest any reason to doubt that anti-microbial compounds could be used in the claimed invention.

It is well established that:

“... a specification disclosure which contains a teaching of the manner and process of making and using the invention in terms which correspond in scope to those used in describing and defining the subject matter sought to be patented *must* be taken as in compliance with the enabling requirement of the first paragraph of § 112 *unless* there is reason to doubt the objective truth of the statements contained therein which must be relied on for enabling support” *Fiers v. Revel*, 25 USPQ2d 1601, 1607 (Fed. Cir. 1993)(emphasis in original).

Since there is not reason to doubt the objective truth of Applicant’s specification, the Office Action does not provide a *prime facie* showing of non-enablement.

The Office Action states that, “[t]he working examples are limited to anti-microbial agents FUNGITROL 11, PROPYL PARABENS, BUTYL PARABENS, AMERSTAT 300, NUOCIDE 960, NUOSEPT S, TROYSAN 174P, CANGUARD 409, IRAGANSAN DP 400, and MICAL WP.” Office Action at 9. However, according to the Manual of Patent Examination Procedure (MPEP) states that for a claimed genus, representative examples together with a statement applicable to the genus as a whole is ordinarily sufficient if one skilled in the art (in view of level of skill, state of the art and the information in the specification) would expect the claimed genus could be used in that manner without undue experimentation. Proof of enablement will be required for other members of the claimed genus only where adequate reasons are advanced by the examiner to establish that a person skilled in the art could not use the genus as a whole without undue experimentation. See, M.P.E.P. 2164.02. Here, the specification provides numerous working examples of anti-microbial agents. The Office Action has not advanced any reasons as to why the person having ordinary skill would not find the specification sufficiently enabling for the claims.

With regard to the issues of amount of direction or guidance presented and predictability, “[i]t is well settled that patent applicants are not required to disclose every species encompassed by their claims, even in an unpredictable art [and] a sufficient disclosure [can be provided] either through illustrative examples or terminology, to teach those of ordinary skill how to make and use the invention as broadly as it is claimed.” *Enzo Biochem Inc. v. Calgene Inc.*, 188 F.3d 1362 (Fed. Cir. 1999). According to the Office Action, “Applicants have failed to provide guidance as to shown the other antimicrobial agents or other antimicrobial metals or metal ions are effective in the coated powder composition.”

Applicants have provided considerable guidance regarding the antimicrobial agents of the invention. The specification recites that the anti-microbial agents can include, but are not limited to, phthalimides, acetamides, phthalonitriles, hydroxy benzoates, isothiazolinones, nitropropane diols, carbamates, methyl ureas, benzimidazoles, salicylanilides, mercury acetates, organozinc compounds, metals such as silver, copper and zinc, and ions of such metals. Moreover, the specification gives the person having ordinary skill in the art examples of suitable commercially available examples of the different solid anti-microbial agents.

Thus, the present specification is sufficient to teach those of ordinary skill in the art how to make and use the invention as claimed. Accordingly, the objection to the specification and rejection of claims under 35 U.S.C. § 112, first paragraph, as failing to provide an enabling disclosure should be withdrawn.

In view of the above, Applicants believe the pending application is in immediate condition for allowance. Applicants respectfully request a notice of allowance on all pending claims. If the Examiner should believe that anything further may be required to place this application in even better form for allowance, he is cordially invited to telephone the undersigned attorney for Applicants.

Should there be any fee due in connection with the filing of this Response To Non-Final Office Action please charge such fee to Deposit Account No. 04-1928 (E. I. du Pont de Nemours and Company).

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'St - Benjamin', written over the typed name.

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Dated: November 15, 2005